



Docket No.: SOA-330
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Masahiro Nakano

Application No.: 09/827,950

Confirmation No.: 6685

Filed: April 9, 2001

Art Unit: 2611

For: METHOD AND APPARATUS FOR
NOTIFYING USERS OF FILTERED E-MAIL
USING A SET TOP BOX

Examiner: K. O. T. Bui

APPELLANT'S BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

This is an Appeal Brief under 37 C.F.R. §41.37 appealing the final decision of the Examiner dated August 10, 2005. Each of the topics required by 37 C.F.R. §41.37 is presented herewith and is labeled appropriately.

This brief is in furtherance of the Final Office Action on August 10, 2005.

A Notice of Appeal and one-month extension was filed in this case on December 12, 2005.

Because February 12, 2006, two months after the filing of the Notice of Appeal, falls on a Sunday, the period for response is extended to February 13, 2006, which is the next day that is neither a Saturday, Sunday nor a Federal holiday in the District of Columbia.

I. REAL PARTY IN INTEREST

Sony Corporation of Tokyo, Japan and Sony Electronics, Inc. of Park Ridge, New Jersey (hereinafter collectively "Sony") are the real parties in interest of the present application. An assignment of all rights in the present application to Sony was executed by the inventors and recorded by the U.S. Patent and Trademark Office at **reel 012617, frame 0298**.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-18 (Rejected);

Claims 19 (Canceled);

Claims 20-21 (Rejected).

IV. STATUS OF AMENDMENTS

Subsequent to the final rejection of August 10, 2005, an Amendment After Final Action (37 C.F.R. Section 1.116) has been filed on October 20, 2005. The Advisory Action of November 15, 2005 indicates that the Amendment of October 20, 2005 would be entered for the purposes of appeal.

No other Amendment has been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following description is provided for illustrative purposes and is not intended to limit the scope of the invention.

The present invention relates to the field of set top boxes. More particularly, the invention relates to set top boxes working with e-mail servers to provide notification to users of the arrival of selected e-mails.

Disclosed is an apparatus for filtering electronic mail and notifying a user, residing in a set top box (10) connected between a television content provider, an Internet provider having an e-mail server (40), and a television (12).

In particular, the apparatus includes a software program application (38) which enables a user to specify e-mail filter criteria (36) and a notification icon (60) which then retains and stores the e-mail filter criteria (36) and the notification icon (60) (Substitute specification at page 11, line 17 through page 13, line 26). Also found within the apparatus is a querying module contained within the software program application (38) which queries the e-mail server (36) to determine whether e-mail fulfilling the e-mail filter criteria (36) has arrived at the e-mail server (40) and a notifying module contained within the software program application (38), wherein, upon arrival of an e-mail fulfilling the e-mail filter criteria (36), the software program application (38) notifies the user by posting the notification icon (60) to the set top box (10) (Substitute specification at page 10, lines 14-22, and page 11, line 17 through page 13, line 26).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for consideration in this appeal are as follows:

Whether the Examiner erred in rejecting claims 1-4 and 6-21 under 35 U.S.C. §102 as allegedly being anticipated by U.S. Patent No. 6,373,817 to Kung et al. (Kung).

Whether the Examiner erred in rejecting claim 5 under 35 U.S.C. §103 as allegedly being unpatentable over Kung in view of U.S. Patent No. 6,397,167 to Skinner et al. (Skinner).

These issues will be discussed hereinbelow.

VII. ARGUMENT

In the Final Office Action of August 10, 2005:

The Examiner erred in rejecting claims 1-4 and 6-21 under 35 U.S.C. §102 as allegedly being anticipated by Kung.

The Examiner erred in rejecting claim 5 under 35 U.S.C. §103 as allegedly being unpatentable over Kung in view of Skinner.

For at least the following reasons, Appellant submits that these rejections are both technically and legally unsound and should therefore be reversed.

Grouping of claims

Claims 1-18 and 20-21 are currently pending in this application, with claims 1, 20, and 21 being independent. For purposes of the issues presented by this appeal:

Claims 1-4, 6, 7, 10-18 stand or fall together.

Claim 5 stands or falls alone.

Claims 8, 9 stand or fall together.

Claim 19 stands or falls alone.

Claim 20 stands or falls alone.

Claim 21 stands or falls alone.

The arguments set forth in the following section provide reasons why these claims are considered patentable, 37 C.F.R. §41.37(c) (1) (vii).

Advisory Action

The Advisory Action contends that claims 1, 20 and 21 should have been rejected under 35 U.S.C. §112, second paragraph.

In particular, the Final Office Action contends that *the reason was a set top box itself is just a cable decoder, and it does not have a visual screen for posting “notification icons” to the user as repeatedly claimed and argued by the applicants* (Advisory Action at page 2).

In response, no rejection of claims 1, 20 and 21 under 35 U.S.C. §112, second paragraph has been made within the Final Office Action. If a rejection under 35 U.S.C. §112, second paragraph is intended, practice and procedures within the U.S. Patent and Trademark Office dictate this rejection should occur within the context of a properly stated Office Action. M.P.E.P. §707.07.

Moreover, the claims are believed to be facially clear and are supported by the specification as originally filed. The claim language is unambiguous.

While the claims may be open to a set top box having a visual screen, the claims are not limited to requiring the set top box to include a visual screen.

Such a reconstruction made in the Advisory Action of requiring a set top box of the claimed invention to include a visual screen is merely an attempt to redefine the invention in a manner different than from what is disclosed within the specification and set forth within the claims. Such reconstruction is without authority under Title 35 U.S.C., Title 37 C.F.R., the

M.P.E.P., and relevant case law; such reconstruction is therefore deemed improper. See M.P.E.P. §2164.08.

The Examiner erred in rejecting claims 1-4 and 6-21 under 35 U.S.C. §102 as allegedly being anticipated by Kung.

Claims 1-4, 6, 7, 10-18 - Claim 1 is drawn to an apparatus comprising:

a software program application which enables a user to specify e-mail filter criteria and a notification icon which then retains and stores said e-mail filter criteria and said notification icon;

a querying module contained within said software program application which queries said e-mail server to determine whether e-mail fulfilling said e-mail filter criteria has arrived at said e-mail server; and

a notifying module also contained within said software program application,

wherein, upon arrival of an e-mail fulfilling said e-mail filter criteria, said software program application notifies the user by posting said notification icon to the set top box.

This rejection is traversed at least for the following reasons.

Kung - Kung arguably teaches an IP central station 200 and a broadband residential gateway 300 (Kung at Figure 1).

Kung arguably teaches the IP central station 200 as having a multimedia server 222 that may be configured to support e-mail (for example, html) messages (Kung at column 13, lines 10-12). Where the multimedia server 222 of Kung provides storage for the multimedia

messages, a database may be utilized for indexing, storage and retrieval of such messages (Kung at column, lines 20-24).

However, the Final Office Action and the Advisory Action fail to highlight with particularity the feature within Kung that is intended to be a querying module contained within a software program application which queries the multimedia server 222 to determine whether e-mail fulfilling e-mail filter criteria has arrived at the multimedia server 222.

Thus, the Final Office Action and the Advisory Action fail to show the presence of a querying module contained within the software program application which queries the e-mail server to determine whether e-mail fulfilling the e-mail filter criteria has arrived at the e-mail server, as claimed.

Additionally, Kung *fails* to disclose, teach or suggest a notifying module also contained within the software program application, as claimed.

The Advisory Action appears to identify the broadband residential gateway 300 as the set top box found within the claimed invention (Advisory Action at pages 2-3).

Upon review, Kung arguably teaches that the broadband residential gateway 300 may be variously configured to provide functionality to one or more TVs (using, for example, either an integrated or separate decoder functionality, for example, set top box 350) (Kung at Figure 3, column 19, lines 9 and 13-15).

However, Kung fails to disclose, teach, or suggest that upon arrival of an e-mail fulfilling an e-mail filter criterion, a software program application *notifies the user by posting the notification icon to the set top box 350*.

Kung arguably teaches that the display 338 may include, for example, an interactive LED/LCD module positioned in a suitable location such as *within or attached to the broadband residential gateway 300* (Kung at Figure 3, column 22, lines 37-39). The display 338 may also include touch screen capabilities that allow information to be input via a plurality of interrelated on-screen prompts, on-screen icons, and/or a keypad (for example, an alphanumeric keyboard) (Kung at column 22, lines 52-57). In one embodiment of the display 338 operation, a user may

touch an icon representing a pending voicemail and/or multimedia mail message (Kung at column 22, lines 58-60). In embodiments where the broadband residential gateway 300 supports multiple mailboxes, the icons on the LCD/LED may be personalized to show the identity of the owner of the message (Kung at column 23, lines 23-26).

Nevertheless, Kung fails to disclose, teach or suggest that upon arrival of a multimedia mail message that fulfills a criterion, a software program application notifies the user by posting the icon to the display 338.

Thus, Kung fails to disclose, teach, or suggest that upon arrival of an e-mail fulfilling e-mail filter criteria, a software program application notifies the user by posting the notification icon to the set top box, as claimed.

Claims 8, 9 - Within claim 8 said software program application further includes means for notifying the user through the use of a tone generated through the television speaker.

This rejection is traversed at least for the reasons provided hereinabove with respect to claim 1, and for the following reasons.

Kung arguably teaches that the broadband residential gateway 300 may be variously configured to, for example, provide high-speed cable modem capabilities to interconnect one or more associated PCs with each other and with the remainder of the broadband network 1, provide functionality to one or more TVs (using, for example, either an integrated or separate decoder functionality, for example, set top box 350), one or more telephone connections such as plain old telephone service (POTS) phones and/or digital telephones, displays, wireless interfaces, voice processing, remote control interface, display interface, and/or administrative functions (Kung at column 19, lines 9-19).

Kung arguably teaches that although the illustration of a display, display drivers, and touch screen logic device 338 suggests that the a display is integral to the broadband residential gateway 300, alternative embodiments of the broadband residential gateway 300 may provide a user interface via the TV screen, PC screen, video telephone, and/or other display device in

addition to, or in lieu of, a display integral to the broadband residential gateway 300 (Kung at column 20, lines 60-67).

Kung arguably teaches that the external/internal Intercom Module (IM) 344 may include one or more microphones/speakers, voice CODECs, telephony processors, and/or interface ports (Kung at column 21, lines 14-16).

Kung arguably teaches that other customer premise equipment 102 devices such as one or more televisions (TV) 106, personal computers (PC) 108, and telephones 110, etc., may be connected to the broadband residential gateway 300 via various ports as discussed above (Kung at Figure 4, column 25, lines 1-5).

Kung arguably teaches that the called party is alerted via distinctive ringing or other alerting means that a chasing call is for them and/or advised via their remote control or wireless alerter if the unit is equipped with a display, or a speaker at the pool or other terminal at the pool that the called party should take the multimedia call at their personal computer in their office (Kung at column 37, lines 56-61).

Nevertheless, Kung fails to disclose, teach or suggest software program application that includes means for notifying the user through the use of a tone generated through the television speaker.

Claim 19 has been canceled within the Amendment After Final Action (37 C.F.R. Section 1.116) of October 20, 2005.

Claim 20 is drawn to an e-mail filtering and notification apparatus, comprising:

set top box, connected between a TV content provider, an Internet provider having an e-mail server, and a TV;

user-input means for allowing a user to specify e-mail filter criteria and a notification icon;

retaining and storing means for retaining and storing said criteria and said notification icon;

querying means, for querying said e-mail server to determine whether e-mail fulfilling said user criteria has arrived at said e-mail server; and

notification means for notifying the user of said arrival by posting said notification icon to the Set Top Box,

wherein said notification icon relates to the subject matter of said arriving e-mail.

At least for the reasons provided hereinabove with respect to claim 1, Kung fails to disclose, teach or suggest all claimed features.

Claim 21 is drawn to a computer readable medium comprising:

a software program application that enables a user to specify e-mail filter criteria and a notification icon which then retains and stores said e-mail filter criteria and said notification icon;

a querying module that queries said e-mail server to determine whether e-mail fulfilling said e-mail filter criteria has arrived at said e-mail server; and

a notifying module wherein, upon arrival of an e-mail fulfilling said criteria, said software program application notifies the user by posting said notification icon to the set top box.

At least for the reasons provided hereinabove with respect to claim 1, Kung fails to disclose, teach or suggest all claimed features.

The Examiner erred in rejecting claim 5 under 35 U.S.C. §103 as allegedly being unpatentable over Kung in view of Skinner.

Claim 5 - Within claim 5, said set top box contains a single-tasking Operating System and said software program application remains in memory as a Terminate and Stay Resident program and runs intermittently at user-configurable intervals.

This rejection is traversed at least for the reasons provided hereinabove with respect to claim 1 and at least for the following reasons.

The Final Office Action *admits* that Kung fails to disclose, teach or suggest a set top box that contains a single-tasking Operating System and said software program application remains in memory as a Terminate and Stay Resident program and runs intermittently at user-configurable intervals (Final Office Action at page 7).

Skinner - Skinner has been provided in the Final Office Action for the features that are deficient from within Kung.

Skinner arguably teaches a time and activity tracker with a hardware abstraction layer. Skinner arguably teaches the addition of the hardware abstraction layer 101 provides the capability of monitoring, i.e., detecting, activities of multiple types of input devices, such as remote controls for TV set top boxes (Skinner at column 8, lines 21-24).

However, Skinner fails to disclose, teach, or suggest that upon arrival of an e-mail fulfilling the e-mail filter criteria, a software program application *notifies the user by posting the notification icon to a set top box*.

At least for the reasons provided hereinabove with respect to claim 1, Kung and Skinner, either individually or as a whole, fails to disclose, teach or suggest all claimed features.

Conclusion

The claims are considered allowable for the same reasons discussed above, as well as for the additional features they recite.

Reversal of the Examiner's decision is respectfully requested.

The claims are considered allowable for the same reasons discussed above, as well as for the additional features they recite.

Reversal of the Examiner's decision is respectfully requested.

Dated: February 13, 2006

Respectfully submitted,

By _____
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CLAIMS APPENDIX

1. (Previously presented) An apparatus for filtering electronic mail and notifying a user, residing in a set top box connected between a television content provider, an Internet provider having an e-mail server, and a television, comprising:

a software program application which enables a user to specify e-mail filter criteria and a notification icon which then retains and stores said e-mail filter criteria and said notification icon;

a querying module contained within said software program application which queries said e-mail server to determine whether e-mail fulfilling said e-mail filter criteria has arrived at said e-mail server; and

a notifying module also contained within said software program application,

wherein, upon arrival of an e-mail fulfilling said e-mail filter criteria, said software program application notifies the user by posting said notification icon to the set top box.

2. (Previously presented) An apparatus as in claim 1, wherein

the connection between said set top box and said e-mail server is permanent, so that said software program application continually queries said e-mail server.

3. (Previously presented) An apparatus as in claim 1, wherein

the connection between said set top box and said e-mail server is non-permanent, so that said software program application queries said e-mail server at specific timed intervals.

4. (Previously presented) An apparatus as in claim 1, wherein
said set top box contains a multi-tasking Operating System and said software program application runs on top of said Operating System.
5. (Previously presented) An apparatus as in claim 1, wherein
said set top box contains a single-tasking Operating System and said software program application remains in memory as a Terminate and Stay Resident program and runs intermittently at user-configurable intervals.
6. (Previously presented) An apparatus as in claim 1, wherein
said software program application further includes means for notifying the user of the existence of e-mail messages fulfilling said e-mail filter criteria through said notification icon on the television screen.
7. (Previously presented) An apparatus as in claim 6, wherein
said notification icon is configurable by the user, and reflects the content of the e-mail filter criteria.
8. (Previously presented) An apparatus as in claim 1, wherein
said software program application further includes means for notifying the user through the use of a tone generated through the television speaker.

9. (Previously presented) An apparatus as in claim 8, wherein
said tone is configurable by the user, and reflects the content of the e-mail filter criteria.
10. (Previously presented) An apparatus as in claim 6, wherein
said notifying means notifies the user of a plurality of said e-mail messages wherein each e-mail message satisfies different filter criteria and has a different user notification icon.
11. (Previously presented) An apparatus as in claim 1, wherein
said software program application further includes means for querying said e-mail server upon power-up of said set top box, and immediately notifies the user of the existence of any e-mail messages satisfying the user-specified e-mail filter criteria.
12. (Previously presented) An apparatus as in claim 1, wherein
said software program application notifies the user via a pager rather than through said set top box.
13. (Previously presented) An apparatus as in claim 1, wherein
said software program application notifies the user of the existence of a telephone call with Caller ID satisfying said e-mail filter criteria, instead of an e-mail message.

14. (Previously presented) An apparatus as in claim 1, wherein
said software program application notifies the user of another user attempting to
make Instant Message contact with the user.
15. (Previously presented) An apparatus as in claim 1, wherein
newer versions of said software program application are downloaded to said set top
box by said Internet provider.
16. (Previously presented) An apparatus as in claim 15, wherein
said downloading of newer versions can distinguish between different types of set top
boxes, and make adjustments to the content of said download accordingly.
17. (Previously presented) An apparatus as in claim 1, wherein
said software program application is not resident on said set top box, but is resident
on said e-mail server.
18. (Previously presented) An apparatus as in claim 1, wherein
said set top box is connected to said e-mail server through a middle server, where
said software program application is resident on said middle server.

19. (Canceled)

20. (Previously presented) An e-mail filtering and notification apparatus, comprising:

set top box, connected between a TV content provider, an Internet provider having an e-mail server, and a TV;

user-input means for allowing a user to specify e-mail filter criteria and a notification icon;

retaining and storing means for retaining and storing said criteria and said notification icon;

querying means, for querying said e-mail server to determine whether e-mail fulfilling said user criteria has arrived at said e-mail server; and

notification means for notifying the user of said arrival by posting said notification icon to the Set Top Box,

wherein said notification icon relates to the subject matter of said arriving e-mail.

21. (Previously presented) A computer readable medium for filtering electronic mail and notifying a user, residing on a set top box connected between a television content provider, an Internet provider having an e-mail server, and a television, comprising:

a software program application that enables a user to specify e-mail filter criteria and a notification icon which then retains and stores said e-mail filter criteria and said notification icon;

a querying module that queries said e-mail server to determine whether e-mail fulfilling said e-mail filter criteria has arrived at said e-mail server; and

a notifying module wherein, upon arrival of an e-mail fulfilling said criteria, said software program application notifies the user by posting said notification icon to the set top box.

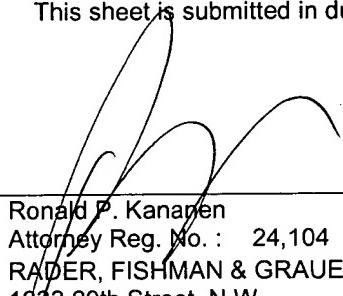
EVIDENCE APPENDIX

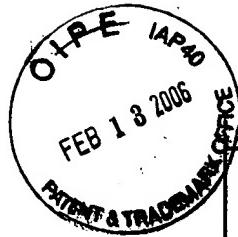
There is no other evidence which will directly affect or have a bearing on the Board's decision in this appeal.

RELATED PROCEEDINGS APPENDIX

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.



TRANSMITTAL OF APPEAL BRIEF		Docket No. SOA-330
In re Application of:		
Application No. 09/827,950-Conf. #6685	Filing Date April 9, 2001	Examiner K. O. T. Bui Group Art Unit 2611
Invention: Method And Apparatus For Notifying Users Of Filtered E-Mail Using A Set Top Box		
<u>TO THE COMMISSIONER OF PATENTS:</u>		
Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>12-12-2005</u>		
The fee for filing this Appeal Brief is <u>\$ 500.00</u>		
<input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity		
<input type="checkbox"/> A petition for extension of time is also enclosed.		
The fee for the extension of time is _____		
<input type="checkbox"/> A check in the amount of _____ is enclosed.		
<input checked="" type="checkbox"/> Charge the amount of the fee to Deposit Account No. <u>18-0013</u> This sheet is submitted in duplicate.		
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.		
<input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>18-0013</u> This sheet is submitted in duplicate.		
 Dated: <u>February 13, 2006</u>		
<p>Ronald P. Kanapen Attorney Reg. No.: 24,104 RAIDER, FISHMAN & GRAUER PLLC 1233 20th Street, N.W. Suite 501 Washington, DC 20036 (202) 955-3750</p>		



PTO/SB/17 (12-04v2)

Approved for use through 7/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

Applicant claims small entity status. See 37 CFR 1.27

Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).		Complete if Known	
FEETRANSMITTAL For FY 2005		Application Number	09/827,950-Conf. #6685
		Filing Date	April 9, 2001
		First Named Inventor	Masahiro Nakano
		Examiner Name	K. O. T. Bui
		Art Unit	2611
<input type="checkbox"/>	Applicant claims small entity status. See 37 CFR 1.27		
TOTAL AMOUNT OF PAYMENT		(\$)	500.00
		Attorney Docket No.	
		SOA-330	

METHOD OF PAYMENT (check all that apply)

Check Credit Card Money Order None Other (please identify): _____

Deposit Account Deposit Account Number: 18-0013 Deposit Account Name: Rader, Fishman & Grauer PLLC

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below Charge fee(s) indicated below, except for the filing fee

Charge any additional fee(s) or underpayment of fee(s), under 37 CFR 1.16 and 1.17 Credit any overpayments

FEES CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

<u>Application Type</u>	FILING FEES		SEARCH FEES		EXAMINATION FEES		
	<u>Fee (\$)</u>	<u>Small Entity</u>	<u>Fee (\$)</u>	<u>Small Entity</u>	<u>Fee (\$)</u>	<u>Small Entity</u>	<u>Fees Paid (\$)</u>
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>
50	25
200	100
360	180

3 APPLICATION SIZE EEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets **Extra Sheets** **Number of each additional 50 or fraction thereof** **Fee (\$)** **Fee Paid (\$)**

4 OTHER FEE(S)

Non-English Specification: \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1402 Filing a brief in support of an appeal

500 00

SUBMITTED BY				
Signature		Registration No. (Attorney/Agent)	24,104	Telephone (202) 955-3750
Name (Print/Type)	Ronald P. Kananen		Date	February 13, 2006